

**REMARKS**

Favorable reconsideration of this application is respectfully requested in view of the amendments above and the following remarks. By virtue of the amendment, claims 1-3, 7, 8 and 12-20 are pending in the present application of which claims 1, 7, 13 and 18 are independent.

Claims 1-3, 7-8 and 10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hoffman et al. (5,613,012). This rejection is traversed for the reasons set forth below.

**Personal Interview Conducted**

The Applicant wishes to thank Examiner Lee for granting the personal interview conducted on June 8, 2004. Two issues were discussed. The first issue was directed to whether Hoffman teaches or suggests storing a digital signature in a memory of a remote control. No agreement was reached as to whether Hoffman et al. teaches or suggests storing a digital signature in a memory of a remote control.

The second issue was directed to whether Hoffman et al. teaches or suggests storing the digital signature in memory after a transaction is completed or canceled. Specifically, Examiner Lee was referred to column 16, lines 43-48 of Hoffman et al. which discloses that user transaction information, such as a personal identification code, biometric, etc., are not stored in Hoffman et al. after a transaction is completed or canceled to avoid perpetuating fraud with that information. Examiner Lee indicated that amending the independent claims to include a feature of storing the digital signature in memory after a transaction is completed or canceled more than likely overcomes Hoffman et al.

**Claim Rejection Under 35 U.S.C. §103**

Claims 1-3, 7-8 and 10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hoffman et al.

The test for determining if a claim is rendered obvious by one or more references for purposes of a rejection under 35 U.S.C. § 103 is set forth in MPEP § 706.02(j):

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Therefore, if the above-identified criteria are not met, then the cited reference(s) fails to render obvious the claimed invention and, thus, the claimed invention is distinguishable over the cited reference(s).

Independent claims 1, 7, 13 and 18 have been amended to include that the digital signature remains stored in the memory means after the transaction is completed or canceled. This feature is not taught or suggested by Hoffman et al. as agreed upon in the interview. As discussed, the intent of Hoffman et al. is to delete all of a user's personal information from a device used to perform an electronic transaction after the transaction is completed or canceled. *See* Hoffman et al., column 16, lines 43-50. This prevents fraudulent use of the user's information. Accordingly, Hoffman et al. fails to teach or suggest storing the digital signature after a transaction is completed or canceled. In addition, it would not have been obvious to modify Hoffman et al. to include storing the digital signature after the transaction

is completed or canceled because Hoffman teaches away from doing so. In particular Hoffman states that it is important not to keep copies of registers or keys and to clear registers and keys after a transaction is keyed or canceled. This helps to minimize fraud in Hoffman et al. Thus, Hoffman et al. fails to teach or suggest all the features of claims 1-3, 7, 8 and 12-20 and these claims are believed to be allowable.

In addition, independent claims 1 and 18 recite storing a digital signature in a remote control. Independent claim 7 recites a digital signature is stored in memory, and a controller controlling functions of a television set. Independent claim 13 recites a digital signature stored in a memory of a portable digital assistant. These features are not taught or suggested by Hoffman et al. As discussed in the interview, the rejection of claims 1, 7, 13, and 18 states that Hoffman teaches storing a digital signature of a user in a memory of a remote control. The rejection specifically refers to column 32, lines 26-33 of Hoffman et al. In this passage, Hoffman et al. is referring to an electronic signature terminal (EST) used with a specific PC embodiment described in Hoffman et al. *See* column 32, lines 41-43. In that embodiment, referred to as BIA/PC, a biometric input apparatus (BIA) is connected to a personal computer (PC), and the EST is connected to the BIA/PC. Hoffman et al., however, fails to teach or suggest the EST connected to a remote control for storing a digital signature.

In fact, during the interview Examiner Lee agreed that Hoffman et al. fails to specifically teach using the EST with a remote control in column 32, lines 35-65. However, Examiner Lee alleged that Hoffman et al. teaches an embodiment of the BIA connected to a remote control and TV as shown in figure 1 and described in column 18, lines 6-22, and thus Hoffman et al. teaches using the EST with the remote control to store a digital signature in the remote control.

Again, as stated in the interview and above, Hoffman et al. is absolutely devoid of any teaching of storing a digital signature in a remote control. If this rejection is maintained, the Applicant requests that Examiner Lee specifically identify where Hoffman et al. discloses using a remote control to store an electronic signature.

Also, independent claims 13 and 18 include features associated with storing a digital signature in a personal digital assistant. Hoffman et al. is absolutely devoid of any teaching of storing a digital signature in a personal digital assistant. If this rejection is maintained, the Applicant requests that Examiner Lee specifically identify where this feature is disclosed in Hoffman et al.

Furthermore, it would not have been obvious to one of ordinary skill in the art to modify Hoffman et al. to store a digital signature in the remote control or in a personal digital assistant. During the interview, Examiner Lee referred to his obviousness statement at the bottom of page 3 indicating that it would have been obvious to modify Hoffman as recited in the claims to ensure that chances for fraud and theft are minimized. Firstly, the teaching of using a remote control to store a digital signature is being provided from the Applicants invention rather than the prior art. Secondly, it unclear how storing a digital signature in the remote control minimizes the chances for fraud and theft. On the contrary, storing a digital signature in the remote control would increase the chances for fraud and theft, because the remote control is easily stolen from a premises because of its portability, resulting in a digital signature being stolen.

**Finality Must Be Withdrawn If The Amendment After Final Is Not Entered**

As stated above, Hoffman et al. fails to teach storing a digital signature in a remote control or a personal digital assistant. Accordingly, the rejection over Hoffman et al. cannot be maintained. If the rejection is maintained, the Applicant requests that Examiner Lee specifically identify where these features are disclosed in Hoffman et al.

If Examiner Lee now contends that Hoffman et al. does not teach these features but it would have been obvious to one of ordinary skill in the art to modify Hoffman et al. to include these features, finality must be withdrawn because the rejection of independent claims 1, 7, 13, and 18 provided in the Office Action does not state it would have been obvious to modify Hoffman et al. to include these features. In fact, the rejection specifically states that Hoffman et al. teaches storing a digital signature in a memory of a remote control, which is contrary to a new Examiner's argument that Hoffman et al. does not teach storing a digital signature in a memory of a remote control but it would have been obvious to modify Hoffman et al. to teach this feature.

During the interview, Examiner Lee referred to the last paragraph of his rejection of claims 1, 7, 13, and 18, which stated:

Therefore, it would have been obvious to one [of] ordinary skill in the art at the time the invention was made to have used Hoffman's system in authorizing electronic transactions via the application of digital signatures as recited in the claims, to ensure the chances for fraud and theft are minimized within the system.

It is clear that this statement of obviousness is not referring to the fact that Hoffman et al. fails to teach storing a digital signature in a remote control but it would have been obvious to modify Hoffman et al. to do so, because the third paragraph of the rejection already stated

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that storing a digital signature in a remote control is taught by Hoffman et al. At best the Examiner may argue that this obviousness statement is referring to the claimed personal digital assistant also not taught by Hoffman et al. and not previously referenced in the rejection.

Examiner Lee is reminded that it is important for an Examiner to properly communicate the basis for a rejection so that the issues can be identified early and the Applicant can be given fair opportunity to reply. See MPEP 706.02(j), Contents of a 35 U.S.C. 103 Rejection. If Examiner Lee is now alleging that Hoffman et al. does not teach storing a digital signature in a remote control (contrary to the statement in the third paragraph of the rejection) but it would have been obvious to one of ordinary skill in the art to modify Hoffman et al. to include this features, finality must be withdrawn in order to give the Applicant an opportunity to respond to the new rejection.

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**Conclusion**

In light of the foregoing, withdrawal of the rejections of record and allowance of this application are earnestly solicited.

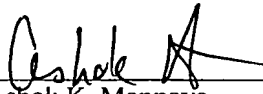
Should the Examiner believe that a telephone conference with the undersigned would assist in resolving any issues pertaining to the allowability of the above-identified application, please contact the undersigned at the telephone number listed below. Please grant any required extensions of time and charge any fees due in connection with this request to deposit account no. 08-2025.

Respectfully submitted,

Douglas WEIGEL

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By

  
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Ashok K. Mannava  
Registration No. 45,301

MANNAVA & KANG, P.C.  
281 Murtha Street  
Alexandria, VA 22304  
(703) 628-1461  
(703) 991-1162 (facsimile)